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POCKET NO.: 200204US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Eva KONDOROSI, et al.

: GROUP ART UNIT: 1638

SERIAL NO.: 09/701,572

:

FILED: JANUARY 29, 2001

: EXAMINER: COLLINS

FOR: PLANT PROTEIN WITH REPEATED WD40 MOTIFS, NUCLEIC ACID CODING  
FOR SAID PROTEIN, AND USES THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action dated February 27, 2002, Applicants elect, with  
traverse, Group II, Claims 3-7.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-2, drawn to a plant protein with repeated WD40 motifs  
belonging to the FZR subfamily;

Group II: Claims 3-7, drawn to a nucleic acid fragment, a vector, a cell, and a  
transgenic plant;

Group III: Claims 8-11, drawn to use of a protein; and

Group IV: Claim 11, drawn to use of a nucleic acid sequence.

Applicants elect, with traverse, Group II, Claims 3-7.

Applicants submit that the claims of Groups II and III depend from the claims of  
Group I, and as such these groups can not be separated.

Further, Claim 11 (Group IV) relates to a method of using the protein of Claim 1 (Group I). Accordingly, these groups clearly share a special technical feature. Therefore, these groups can not be separated.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that a lack of unity exists between Groups I-IV, because the special technical feature of the present invention does not define a contribution over the prior art. To support this assertion, the Office cites Luo et al from the International Search Report. However, the Office's assertion is misplaced. As stated on page 4, lines 11-21 of the present application, Luo et al describe a gene from carrot cDNA, which "belongs to a subgroup of proteins with repeated WD40 motifs distinct from the FZR subgroup." In particular, the protein of Luo et al lacks the peptide sequence designated motif II (AYTTLLRTALFG), which corresponds to a motif specific to the FZR family (page 5, lines 21-31). Accordingly, the Office has not made out a proper case under the PCT Rules to support the Restriction Requirement, and as such it should be withdrawn.

Applicants traverse that Restriction Requirement on the additional grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority (see English translation submitted herewith). The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(1) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, the MPEP in §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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